

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action dated September 27, 2002. Claims 19, 22, 25, and 26 are pending in the Application. Applicant respectfully requests reconsideration of all pending claims and favorable action in this case.

Section 103 Rejections of Claims

The Examiner rejects Claims 19, 22, 25, and 26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,583,783 issued to Yasui ("Yasui") in view of U.S. Patent No. 5,470,160 issued to Nowlin ("Nowlin") and in view of U.S. Patent No. 6,029,887 issued to Furuhashi et al. ("Furuhashi"). This rejection is respectfully traversed for the following reasons.

According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations. It is respectfully submitted that Independent Claim 19 is patentable over the art of record because the Examiner has failed to satisfy all of the criteria for a prima facie case of obviousness.

For example, with respect to the first criterion of obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the

combination. M.P.E.P. §2143.01. Thus, the mere fact that the teachings of *Nowlin* may improve the teachings of *Yasui* as asserted by the Examiner does not provide the required suggestion to combine. Nothing in *Yasui*, *Nowlin*, *Furuhashi*, or any other cited reference suggests or motivates the proposed combination. Nor has the Examiner provided any evidence that suggests the proposed modification. The Examiner merely speculates that "it would have been obvious" to make the proposed combination. The Examiner additionally improperly speculates that "one of ordinary skill in the art would have readily recognized" the proposed combination. Thus, the Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required for a proper rejection under 35 U.S.C. §103(a). The M.P.E.P. also confirms that this approach of speculating that one of ordinary skill in the art would have been motivated to combine the references is improper. See M.P.E.P. §2145.

Addressing the references in order, *Yasui* is directed to an apparatus with its primary purpose being to provide a checkwriter capable of printing characters and digits at predetermined positions on a check form without using a separate template. Such an apparatus addresses problems encountered when check forms of different banks have different positions where characters and digits are to be printed. In such an environment, characters and digits may be mislocated from correct positions on some check forms, spoiling the appearance of the check. (See *Yasui*, Column 1, lines 16-34.) Thus, it is a primary purpose of the device of *Yasui* to

provide a checkwriter and method for the proper printing of checks and the avoidance of using format templates.

The device disclosed in *Furuhashi* is an electronic bankbook that offers a payee information area 119, but one that is wholly irrelevant to the teachings of *Yasui* or the subject matter of Independent Claim 19. *Furuhashi* teaches a data input device for customer use 141 for inputting payee information (See *Furuhashi*, Column 16, lines 33-38). By the customer using the payee entry device, he can register all of the possible payee information in the electronic bankbook in advance. Due to this, when in front of the ATM, even in the case of making a money transfer for the first time, it is possible to input to the ATM the payee information just by the simple operation of selecting a payee who has been already registered and it is possible completely to eliminate the troublesome input work of the prior art in respect of the ATM. (See *Furuhashi*, Column 18, lines 10-19.) Thus, *Furuhashi* is concerned with automating the check writing process by storing often-used information, in contrast to *Yasui* which relates to avoidance of templates and accuracy associated with data input. This illogical combination of references is further strained by appending *Nowlin* to support the obviousness rejection. *Nowlin* discloses an apparatus incorporating check sum proof entry that prints a check with an MICR entry which is the proof sum necessary for handling in the proof department. The MICR ink is machine readable so that proofing can be accomplished with substantial reduction of handling while yet accomplishing proper entry of the charges to the account of the depositor. (See *Nowlin*, Column 3, lines 36-43.) However, nowhere in *Nowlin* is there any motivation or suggestion to combine its teachings with the system offered by *Yasui* or by *Furuhashi*. Indeed, each of these references

address separate and distinct problems in the field of check writing. Thus, because of the disparate teachings of the references, there is no suggestion to combine the features of the checkwriter of *Yasui*, the payee information of *Furuhashi*, and the MICR of *Nowlin* to yield the portable check encoding device recited in Independent Claim 19.

Additionally, the Examiner has not cited any language within *Yasui*, *Furuhashi*, or *Nowlin* that would suggest any capability for these references to be combined. In fact, no reason was provided by the Examiner for combining the references as has been proposed. The Examiner has merely provided subjective conclusory "it would have been obvious to combine" statements, using improper hindsight reconstruction without any support for such conclusory statements from any of the cited patents. A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Since the Examiner has not provided any reasoning, let alone objective reasoning, the burden to establish the first criteria of a prima facie case of obviousness has not been met.

Furthermore, if the Examiner modified the combined teachings of *Yasui*, *Furuhashi*, or *Nowlin* to teach the limitations of the pending claims, Applicant would also respond that there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification. The fact that the modification is

possible or even advantageous is not enough. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. As pointed out above, it is a primary purpose of the device of Yasui to provide a checkwriter and method for the proper printing of checks and the avoidance of using formatting templates. If the features of a payee list and MICR technology were somehow incorrectly infused into the system of Yasui, the resulting device would ostensibly lose its intended functionality of offering a unit whose purpose is to ensure accuracy without the use of templates. Therefore, such an interpolation stemming from Yasui would accordingly be improper.

Second, a reasonable expectation of success for the proposed combination has not been shown by the Examiner. The combination of Yasui, Furuhashi, or Nowlin would not be capable of performing the operation required by the claimed invention. There is no showing by the Examiner that the check printing feature of Yasui, the payee information of Furuhashi, and the MICR technology of Nowlin would be able to operate in a portable check-encoding environment. Moreover, there has also been no showing that the combined references would be able to generate checks that include magnetic ink that reflects the amount of the check and the payee as selected from a payee list. The proposed combination attempts to combine divergent data processing techniques that have not been shown to be capable of operating according to any degree of predictability. The Examiner has not addressed the chance that the proposed combination of the Yasui, Furuhashi, or Nowlin patents would have any success whatsoever let alone a reasonable expectation of success. Therefore, Applicant

respectfully submits that the Examiner has failed to establish the second criterion for a prima facie case of obviousness.

Third, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. The claimed invention provides for a device that includes an input device, a memory, a display, a list of payee names, and a printer. By contrast, the proposed combination (at best) requires three separate components and/or devices - the input device of *Yasui*, the MICR technology of *Nowlin*, and the payee information of *Furuhashi*. Thus, the proposed combination does not provide a device that performs all functions required by the claimed invention. Therefore, the Examiner has failed to establish the third criterion for a prima facie case of obviousness.

With no other supporting reference that are combinable with the *Yasui*, *Furuhashi*, or *Nowlin* patents, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combination. The Examiner has not cited any language within the *Yasui*, *Furuhashi*, or *Nowlin* patents, either alone or in combination, that would suggest the desirability of making the claimed invention or providing any motivation to do so. As identified above, subjective conclusions of obviousness are not sufficient to establish a prima facie case of obviousness without some objective reason to modify and to combine the prior art references. Therefore, Applicant respectfully submits that Independent Claim 19 is patentably distinct from the proposed *Yasui-Furuhashi-Nowlin* combination.

Claims 22, 25, and 26 depend from Independent Claim 19 and add a limitation that further distinguishes them from the prior art of record. Therefore Claims 22, 25, and 26 are

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allowable, for example, for the same reasons as identified above. Notice to this effect is respectfully requested.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of Claims 19, 22, 25, and 26.

The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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